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EXAMINER  
DALENCOURT, Y

ART UNIT  
2735

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 15

Application Number: 08/863,037  
Filing Date: 05/23/97  
Appellant(s): Bernard A. Weinstein

Wesley W. Whitmyer  
For Appellant

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed 02/15/200.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

Art Unit: 2735

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant has not provided argument why each claim is allowable. Appellant relies essentially on one argument " a confirmation generated and transmitted by a host computer system upon receipt of a market condition to be monitored ", as such all claims stand or fall together.

**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit: 2735

5,787,402	Potter et al	7-1998
5,270,922	Higgins	12-1993
5,281,962	Vanden Heuvel et al	1-1994

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 - 2, 4, 11 - 12, and 14 - 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter et al ( US 5787402; hereinafter Potter) in view of Higgins ( US 5270922; hereinafter Higgins).
2. Regarding claims 1, 4, 11, and 15 - 16, Potter et al teaches a method and system for performing automated financial transactions involving foreign currencies which comprises a user computer for specifying a market condition to be monitored and a corresponding client ID (10, figure 1 ); an electronic source of updated market data ( col. 14, lines 9 - 29); a host computer system including a database for receiving and storing a plurality of the market conditions specified for monitoring and the corresponding client IDs ( 100, figure 2; col 5, lines 50 - 59 & paragraph

Art Unit: 2735

bridging between col. 4 and col. 5); confirmation data generated and transmitted by said host computer system upon receipt of the specified market condition and corresponding client ID by said database, said confirmation data indicating that the specified market condition has been received by said host computer and will be monitored, and a transmitter responsive to said signal for transmitting notification of the specified market condition (col. 3, lines 1 - 11 & lines 37 - 42).

3. Plotter et al fails to specifically teach a monitoring program executable on said host computer system for comparing each of the specified market conditions stored on said host computer system and said source of updated market data to determine if a specified market condition is found in said source of updated market data, said monitoring program generating a signal if a specified market condition is found to exist, the signal indicative of the found specified market condition and the corresponding client ID stored on said host computer system.

4. However, Higgins teaches, in an art related field of market data notification, a system for distributing, processing and displaying financial information which comprises a monitoring program executable on said host computer system for comparing each of the specified market conditions stored on said host computer system and said source of updated market data to determine if a specified market condition is found in said source of updated market data ( figure 4, col. 8, lines 16 - 24 ); said monitoring program generating a signal if a specified market condition is found to exist the signal indicative of the found specified market condition and the corresponding client ID stored on said host computer system ( figure 4; col. 8, lines 38 - 63) for

Art Unit: 2735

the purpose of providing apparatus and methodology to communicate and display information useful for securities brokers, investors, and others concerned with financial markets.

5. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an electronic source of updated market data; and a monitoring program executable on said host computer system for comparing each of the specified market conditions stored on said host computer system and said source of updated market data to determine if a specified market condition is found in said source of updated market data; said monitoring program generating a signal if a specified market condition is found to exist the signal indicative of the found specified market condition and the corresponding client ID stored on said host computer system in Potter et al's system as taught by Higgins for the purpose of providing apparatus and methodology to communicate and display information useful for securities brokers, investors, and others concerned with financial markets.

6. Regarding claims 2, 12, and 17, Potter et al and Higgins teach all the limitations, and Higgins further teaches a program executable on said user computer for providing share price momentum as market condition to be monitored ( col. 8, lines 38 - 43).

Regarding claim 14, Potter et al and Higgins teach all the limitations, and Potter et al further teaches a computer aided real-time decision support system and method wherein said user computer includes a communication server ( 44, figure 1; col. 4, lines 54 - 59).

Art Unit: 2735

7. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter et al and Higgins as applied to claims 1 and 11, above, and further in view of Vanden Heuvel et al (US 5281962; hereinafter Vanden Heuvel).

Regarding claims 3 and 13, Potter et al and Higgins teach all the limitations but fail to specifically teach a system wherein said user computer specifies the market condition to be monitored in electronic mail format.

However, Vanden Huevel et al teaches, in an art related field of providing information to users, a reliable information service message delivery system wherein said user computer specifies the market condition to be monitored in electronic mail format ( col. 3, lines 24 - 38) for the purpose of reliably delivering information service messages to communication receiver in a communication system.

Thus, it would have been obvious to one of ordinary skill in the art to have used a system wherein said user computer specifies the market condition to be monitored in electronic mail format in Potter et al and Higgins's system as taught by Vanden Huevel for ease of use and also to reliably deliver information service messages to communication receiver in a communication system.

**(11) Response to Argument**

Appellant argues that Potter fails to teach or suggest that a confirmation be generated and transmitted upon receipt of a market condition to be monitored ( page 6, last paragraph ).

However, the examiner asserts that on a one to one basis, a consumer has to verify and sign

Art Unit: 2735

the desired market condition to be monitored. When using computer to computer transactions, and a given market condition is requested to be monitored by a consumer, it would have been obvious to the skilled artisan to also submit a confirmation notice to the consumer to ascertain that the correct market and parameters associated with the consumer's preference data are the ones being monitored. A motivation would have been to prevent the wrong market condition to be monitored which may cause a catastrophic and damaging impact on both the consumer and the financial firm.

Regarding appellant's arguments ( page 7, 1st, 2nd, and 3rd paragraph ), the examiner did not rely on either Higgins, and Vanden Heuvel for the limitation of " a confirmation be generated and transmitted upon receipt of a market condition to be monitored ". Therefore, the argument is moot. Appellant is also directed to column 3, lines 19 - 43 in Potter, where it is discussed a consumer's confirmation of accepting or rejecting an offer. Thus, applying the same principle into confirming a market condition to be monitored would have also been obvious to one skilled in the art for the purpose of avoiding misunderstandings between the two parties.

The claims are not as narrow as the arguments are presented because first of all, they do not specify when confirmation exists ( i.e. immediately upon receipt or later ... after trade), and second of all, they do not specify that " the signal " be separated from the " confirmation data ".



Art Unit: 2735

As such: a fair broad interpretation is one in which the confirmation data is included in the “ signal “ that is generated in response to the specific market condition being met as stated by appellant on page 6 and which is shown by Potter et al.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Y.D

Yves Dalencourt  
April 18, 2000

*EC*  
EDWIN C. HOLLOWAY III  
PRIMARY EXAMINER  
*Conferee*

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600  
*Conferee*

*Michael Horabik*